

Serial No. 10/552,196
Atty. Doc. No. 2003P05273WOUS

Amendments to the Drawings:

The attached sheet of drawings replaces the original sheet 3 including FIG. 3. In FIG. 3, the labels have been provided.

REMARKS

Claims 1-44 were previously canceled. Claims 45-66 were pending. Claims 45, 48, 51, 52, 55 – 58, 61, and 66 have been amended herein with claims 46, 47, 49, 50, 53, 54, and 65 canceled herein. New claims 67 - 72 have been added. Thus, claims 45, 48, 51, 52, 55 – 64, 66 - 72 are presented for examination. Applicant respectfully requests allowance of the present application in view of the foregoing amendments.

Support for the amendments and new claims can be found throughout the specification (as previously amended) including but not limited to paragraphs [0028] – [0029], [0058] – [0061], and [0065] – [0067] and FIG. 4. No new matter has been added.

Drawing Objections

FIG. 3 was objected to because of lack of labels which Applicant has addressed according to the Examiner's suggestion. Accordingly, Applicant requests that the objection be withdrawn.

Response to Rejections Under Section §112

The Examiner rejected claims 45, 48 – 51, 56, 58, and 61 under 35 USC §112 as being indefinite. Applicant has addressed the indefinite issues as suggested by the Examiner and requests that the rejection be withdrawn.

Claim Rejections under 35 U.S.C. §101

Claims 45 - 66 have been rejected under 35 U.S.C. §101. Applicant submits that the pending method claims (45 – 64) are drawn to patent-eligible subject matter under § 101 and that the system claim 66 (and claims depending therefrom) is also drawn to patent-eligible subject matter under § 101. Claim 65 has been cancelled and will not be addressed herein.

The CAFC held that “the machine-or-transformation test outlined by the Supreme Court is the proper test to apply.” *Bilski*, 545 F.3d at 960. “[A]n applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article” into a different state or thing. *Id.* at 961 (citation omitted); *see also Gottschalk v. Benson*, 409 U.S. 63, 70 (1972).

The analysis begins with the threshold question whether the claim recites a process claim before applying the machine-or-transformation (M/T) test. Claims 45 - 65 recite methods for managing the supply of service devices, and is thus directed to a process as set forth in 35 U.S.C. § 101, which can be properly analyzed by applying the M/T test.

Next, the machine prong of the M/T test is applied. Applicant submits that independent claim 45 recites a data processing system comprising a computer in communication with a database accessible across a communication network by one or more client computers wherein the data processing system executes the steps of the claimed process which impose a meaningful limitation to the scope of the claimed process. Thus, claim 45 and the claims depending therefrom are “tied to” a machine, i.e., a data processing system. Moreover, the data processing system is a “particular machine” within the meaning of the M/T test.

The court has provided guidelines that can be appropriately applied that “such programming creates a new machine, because a general purpose computer in effect becomes a special purpose computer once it is programmed to perform particular functions pursuant to instructions from program software.” *In re Alappat*, 33 F.3d 1526, 1549 (Fed. Cir. 1994) (citation omitted), *abrogated by Bilski*, 545 F.3d 943 (regarding the “useful, concrete, and tangible result” test originally set forth in *Alappat* at 1544).

Here, the data processing system recited in claim 45 is programmed to process data in a particular way, i.e., receive requests and perform availability checks in a particular manner. Therefore, the data processing system claimed is a “particular machine” within the meaning of the M/T test. Accordingly, the claims satisfy the machine prong of the M/T test. We do not need to go through the transformation prong of the M/T test after the machine prong of M/T test is passed.

Claim 66 (and the new claims depending therefrom) are system claims which positively recite, for example, a data processing system comprising a computer in communication with a database accessible across a communication network by one or more client computers, and the like, all of which are particular components that make the claim statutory. Each claimed component is a particular apparatus.

Accordingly, Applicant submits that the claims are all statutory under Section 101 and requests that the rejection be withdrawn.

Claim Rejections under 35 U.S.C. 103

Claims 45 – 50, 52 – 53, 55 – 58, 60 – 61, and 63-66 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Glovitz* (5682421) in view of *Sisley* (5467268). Claims 51 and 54 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Glovitz* (5682421) in view of *Sisley* (5467268) further in view of *Chess* (US 2004/0059810). Claim 59 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Glovitz* (5682421) in view of *Sisley* (5467268) further in view of *Rassman* (US 4937743). Claim 62 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Glovitz* (5682421) in view of *Sisley* (5467268) further in view of *Smith* (US 6879962). Applicant respectfully requests withdrawal of the rejection based on the amendments and following remarks.

The Office bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. 103. All words in a claim must be considered for judging the patentability of the claim against the prior art.

Claims 45 provides, in relevant part, for:

“pooling data regarding a plurality of service devices in an **inventory pool** as device data records in a database, wherein the inventory pool comprises service provider inventories for service devices owned by each of the respective plurality of service providers and a device provider inventory for service devices owned by the device provider”

and also checking availability by:

“(i) **searching an inventory of the requesting service provider** in the inventory pool and providing for loaning of the requested service device if located; otherwise, (ii) **searching the device provider inventory** and providing for leasing the requested service device if located; otherwise, (iii) **searching the service provider inventories of other service providers** in the inventory pool and leasing the requested service device if located.”

Similarly, Claim 66 provides, in relevant part, for

“a database in communication with the data processing system, wherein the database comprises **an inventory pool** comprising device data records for service devices, wherein the inventory pool comprises service provider inventories for service devices owned by each of a respective plurality of service providers and a device provider inventory for service devices owned by a device provider”

and checking availability by:

“(i) **searching an inventory of the requesting service provider** in the inventory pool and providing for loaning of the requested service device if located; otherwise, (ii) **searching the device provider inventory** and providing for leasing the requested service device if located; otherwise, (iii) **searching the service provider inventories of other service providers** in the inventory pool and leasing the requested service device if located.”

Without conceding the propriety of the asserted combination, Applicant respectfully submits that the asserted combination does not disclose at least the aforementioned features of claims 45 and 66, because none of the references disclose or suggest the inventory pool of the present invention nor the unique manner of providing the service devices based on an availability check that proceeds in the manner recited in the claims. Furthermore, no teaching or suggestion is present in the references to modify the references to include such features.

Accordingly, even if combined, the references fail to meet the limitations of the invention. Since the references fail to teach or suggest the limitations of the claims, the Office has failed to establish a prima facie case of obviousness. Accordingly, Applicant requests reconsideration and withdrawal of the rejection of claims 45 and 66.

In light of the above, Applicant also respectfully submits that all the dependent claims, at least based on their dependence from claim 45 and 66, as well as on their own merits, are novel and non-obvious, and respectfully requests the Examiner to withdraw the Section 103 rejections and allowance.

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Conclusion

Accordingly, Applicant submits that all claims are in condition for allowance and requests that a Notice of Allowance be issued.

The commissioner is hereby authorized to charge any appropriate fees due in connection with this paper, including the fees specified in 37 C.F.R. §§ 1.16 (c), 1.17(a)(1) and 1.20(d), or credit any overpayments to Deposit Account No. 19-2179.

Respectfully submitted,

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